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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

060258-0279256

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Application Number

09/830,816

Filed

April 27, 2001

First Named Inventor

MUHONEN et al.

Art Unit

2682

Examiner

Dao, Minh D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 41844
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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Telephone number

December 6, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 060258-0279256
Client Reference: 2980523US/VK/HER



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: MUHONEN Confirmation Number: 2170
ET AL.

Application No.: 09/830,816

Group Art Unit: 2682

Filed: April 27, 2001

Examiner: Dao, Minh D.

Title: LOCATION SERVICES IN A PACKET RADIO NETWORK

ATTACHMENT SHEETS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby request that a panel of examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an appeal brief. Appellants assert that the outstanding rejections (now on appeal by virtue of the concurrently filed Notice of Appeal) are clearly improper based both upon errors in facts and the omission of essential elements required to establish a *prima facie* rejection (i.e., the prior art references fail to disclose, teach or suggest all the recited claim features).

APPEALED REJECTIONS

Appellants are appealing the rejection of claims 1-8 and 14-16 under 35 U.S.C. 103(a) as being obvious from Huttunen et al. (U.S. 6,356,761; hereafter "Huttunen") and Forslow (U.S. 6,608,832) and the rejection of claims 9-13 under 35 U.S.C. 103(a) as being obvious from Huttunen, Forslow and Billstrom et al. (U.S. 5,590,133; hereafter "Billstrom").

The appealed rejections are improper because the Examiner has failed to establish a *prima facie* case of obviousness in that the identified motivation to combine the teachings of the prior art references, e.g., Huttunen and Forslow, is insufficient to support an obviousness rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met, the first of which being that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Appellants submit that the Examiner has failed to establish this criterion.

INSUFFICIENT MOTIVATION TO COMBINE TEACHINGS OF REFERENCES

The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Huttunen and Forslow to provide better service for different types of applications regarding time of service, as allegedly suggested by Forslow. However, Forslow merely teaches determining a preferred type of bearer (i.e., connection) when there are a plurality of different applications (see, for example, col. 7, lines 38-42). However, Forslow fails to teach or suggest such a determination when there is only one application available, as in the present invention.

Further, as previously asserted by the Examiner, Forslow merely proposes determining a preferred type of bearer (connection) ... regarding time of service. However, the Examiner has incorrectly paraphrased Forslow because Forslow does not propose determining a preferred type of bearer ... regarding time of service but regarding the nature (real-time or non-real-time) of the service. Thus, this aspect of the identified motivation for combining Huttunen and Forslow is deficient.

Appellants further submit that the claims clearly contemplate only one application at a time, for example, all pending claims recite receiving of a request from a requesting entity and providing a response to the request, wherein the two citations of "request" are in singular form.

CITED PRIOR ART REFERENCES CONTRADICT ONE ANOTHER AND INCORPORATION OF FORSLOW WOULD RENDER HUTTUNEN UNSATISFACTORY FOR ITS ORIGINAL PURPOSE

Moreover, Appellants submit that the cited prior art references' teaching actually contract one another and incorporation of Forslow's teachings would render Huttunen unfit for its original purpose. As indicated above, the claimed invention relates to a method for providing location service information wherein a preferred type of connection is determined. The Examiner has alleged that Forslow discloses similar subject matter. However, Huttunen expressly teaches against determining any preferred type of connection at col. 8, lns. 54 – 62:

The essential feature of the invention is that it provides a possibility for finding e.g. one or several WWW pages on basis of the (geographical) location information based on the location of the mobile subscriber (i.e. mobile station 12). In other words, it provides an access, by means of a circuit switched network (such as the mobile network), from a predetermined area to

an area determined information included in a packet switched network, such as to local WWW documents and/or files of the Internet.

In essence, Huttunen teaches that it is essential that the access to the location information is provided via a circuit switched network. Because Huttunen's teachings require that essential feature, the remaining features of that disclosure cannot be combined with teachings that determine a preferred type of connection because, in Huttunen, there would be only one type of connection available.

Thus, any proposed modification of Huttunen based on Forslow would render Huttunen's system unsatisfactory for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Hence, one of ordinary skill in the art would not have combined the teachings of Huttunen and Forslow; now would he have combined those teachings with Billstrom.

CONCLUSION

Therefore, it is respectfully requested that the panel return a decision concurring with Appellants' position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appealed rejections. Specifically, the subject matter recited in independent claims 1 and 16 are not obvious from the teachings of Huttunen, Forslow and Billstrom. Thus, all pending claims 1-16 are allowable.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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